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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,316	08/19/2001	Laurence E. Holt	1044.003US1	2629

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EXAMINER

FADOK, MARK A

ART UNIT PAPER NUMBER

3625

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/682,316

**Applicant(s)**

HOLT, LAURENCE E.

**Examiner**

Mark Fadok

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

The examiner is in receipt of applicant's response to office action mailed 3/23/2005, which was received 7/15/2005. Acknowledgement is made to the amendment to claim 1, leaving claims 1-3 as pending in the instant applicant. The applicant's amendment and remarks have been carefully considered, but were not found to be persuasive; therefore the previous rejection is restated below:

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are not within the technological arts.

The method as stated only requires a trivial use of technology and can be accomplished without a computer-aided device and is considered to be non-statutory for this reason.

*The claimed invention must utilize technology in a non-trivial manner (Ex parte Bowman, 61 USPQ2d, 1665,1671 (Bd. Pat. App. & Inter. 2001)). Although Bowman is not precedential, it has been cited for its analysis.*

***Claim Rejections - 35 USC § 103***

**Claim 1 rejected under 35 U.S.C. 103(a) as being unpatentable over Pennell (2002/0013788) in view of Chennai (article from PTO 892).**

**In regards to claim 1**, Pennell discloses a method comprising: a user making an order for one or more tangible, physical items,

providing therewith one or more of locations at which the user can receive the order and real-time location access information (FIG 4);

Pennell teaches providing multiple addresses and real time location access information (FIG 4, item 405) and shipping the product to a designated shipping address, but does not specifically mention that the shipping address is confirmed before shipment of the product to the customer. Chennai teaches verifying the address of the recipient before delivery (see entire article), it would have been obvious to a person having ordinary skill in the art to include in Pennell the notification method of Chennai, because this will ensure that the package is delivered promptly and increase the satisfaction of the customer.

**Claim 1 rejected under 35 U.S.C. 103(a) as being unpatentable over Pennell (2002/0013788) in view of Chennai (article from PTO 892) and further in view of Official Notice.**

**In regards to claims 2 and 3**, the combination of Pennell and Chennai teach methods of real time communications, but does not specifically mention that the communication is through an instant message. It was old and well known in the art at the time of the invention to use instant messaging to communicate information in real time. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include instant messaging as a means of communicating real-time with a recipient of a package, because this may be the preferred means of communication used by the customer, therefore including this communication means will increase the probability that the customer will be notified.

***Response to Arguments***

Applicant's arguments filed 7/15/2005 have been fully considered but they are not persuasive.

Applicant argues that the amendment overcomes the previous USC 101 rejection. The examiner disagrees and notes that providing a method in a computerized manner does not connote the use of a computer to perform one or all of the method steps that is required to make the claim statutory.

In regards to claim 1, applicant argues that the combination of Pennell/Chennai does not provide a plurality of shipping locations because only one of the addresses stored in Pennell is listed. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case the address confirmation of Chennai once again asks the purchaser to select from the plurality of addresses home, work or other before actual delivery.

Applicant argues that the combination of Pennell/Chennai does not teach determining the current location where the order should be delivered. The examiner disagrees and directs the applicant's attention to Chennai where the certificates need to be delivered directly to the inventors. Therefore, the address confirmed would necessarily be the current location of the recipient where the certificate should be delivered.

Applicant argues that the combination of Pennell/Chennai does not teach that the determination of the correct address is made "at the time of delivery". The examiner disagrees and notes that applicant's specification does not specifically define what the specific meaning of "at time of delivery" represents. Therefore, the examiner has defined this period as any time prior to the actual delivery.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., delivering the item to a current location of the user. The actual claim delivers the item to an address that was determined from a confirmation step, but is not necessarily the current location of the user since the user may have moved after the determining step.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In regards to claims 2 and 3, a "traverse" is a denial of an opposing party's allegations of fact. The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the

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circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well-known statement during examination, then the object of the well-known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(571) 272-6755**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(571) 272-7159**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **receptionist** whose telephone number is **(571) 272-3600**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***



**Alexandria, Va. 22313-1450**

or faxed to:

**(571) 273-8300** [Official communications; including

After Final communications labeled

"Box AF"]

**(571) 273-6755** [Informal/Draft communications, labeled

"PROPOSED" or "DRAFT"]

A handwritten signature in black ink, appearing to read 'Mark Fadok', with a stylized, flowing script.

Mark Fadok

Primary Examiner